

Appl. No. 09/727,835
Amdt. Dated 06/09/2005
Reply to Office Action of March 9, 2005

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed March 9, 2005. In the Office Action, claims 1-61 were rejected under 35 U.S.C. § 103. Claim 1, 6, 9, 12, 14, 17, 19-21, 46, 49 and 51-53 have been revised. Claims 11, 13, 16, 18 and 50 have been cancelled without prejudice. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

First Rejection Under 35 U.S.C. § 103

Claims 1-5, 9-13, 16-19, 25-28, 33-36, 41-44, 46-50, and 56-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ando (U.S. Patent No. 5,777,614) in view of Kurahashi (U.S. Patent No. 5,687,332). Independent claim 16 and dependent claims 11, 13, 18 and 50 have been cancelled without prejudice. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988)*. Herein, at a minimum, the combined teachings of the cited references do not describe or suggest all the claim limitations.

For instance, with respect to independent claim 1, neither Ando nor Kurahashi, alone or in combination, teach or suggest displaying an animated icon in conjunction with said image. The animated icon is adapted for exchange between the first image-editing equipment to a second image-editing equipment.

With respect to independent claims 9 and 17, neither Ando nor Kurahashi, alone or in combination, teach or suggest a system for editing images that comprises a first animated icon and a second animated icon. The first animated icon is adapted to be displayed in conjunction with the image. Displayed in conjunction with the first animated icon and the image, the second animated icon is adapted to indicate a suggested user response to one of the set of quality-related problems.

The remainder of the claims are dependent claims and should be allowable if the corresponding independent claims are held allowable. Hence, withdrawal of the §103(a) as applied to claims 1-5, 9-10, 12, 16-17, 19, 25-28, 33-36, 41-44, 46-49 and 56-59 is respectfully requested.

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Second Rejection Under 35 U.S.C. § 103

Claims 6, 14, 20-24, 29-32, 37-40, 45, 51-53, 55, and 60 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ando. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

Ando describes an image display control program (22) stored within the hard disk (7) of an editing support system of Figure 1. Applicants agree with the Examiner that Ando does not offer any teaching of moving an animated icon to from one image-editing equipment to another. However, Applicants disagree with the statements in the Office Action that it would not have been obvious to want to move the same icon to different displayed windows for familiarity sake. See paragraph 3 of the Office Action.

With respect to independent claims 1, 6, 20, 24, 32, 40 and 55 for example, the claimed limitation is directed to moving (or exchanging) the claimed automated icon(s) between different equipment. As an illustrative embodiment of the subject application, it is described of a situation where the automated icon is exchanged between one type of equipment (computer) to another type of equipment (digital camera). The claimed invention is not directed to moving the same icon to different displayed windows as alleged in the Office Action, but to different devices.

Moreover, the mere fact that references can be modified does not render the resultant combination obvious unless the reference also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Herein, there is no suggestion by Ando to support movement of the "human image" (image in window B 27) to displays of other devices, especially since the editing support system includes an image input device (camera) and there is clearly no mention or desire based on the teachings of Ando for the human image to be displayed there. See column 1, line 60 of Ando.

Hence, Applicants respectfully request withdrawal of the §103(a) rejection as applied to newly amended independent claims 1 as well as claims 6, 14, 20-24, 29-32, 37-40, 45, 51-53, 55, and 60.

For the record, should the statement be construed as an Official Notice, Applicant timely challenged the Official Notice in accordance with MPEP § 2144.03. Thus, the burden falls upon the Examiner to cite a reference in support of his or her position.

Third Rejection Under 35 U.S.C. § 103

Claims 7, 8, and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Kurahashi and Herz (U.S. Patent No. 5,835,087). Applicants respectfully traverse the rejection in its entirety because a *prima facie* case of obviousness has not been established. However, it is noted that claims 7-8 and 15 depend on independent claims 1 and 9, respectively. Thus, these claims are allowable based on their dependency on the allowable claims. In the event that the appeal is warranted, Applicants respectfully reserve the right to further submit additional grounds for traversing the rejection during the appeal.

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Fourth Rejection Under 35 U.S.C. § 103

Claims 54 and 61 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Kurahashi and Hasegawa (U.S. Patent No. 6,169,854). Applicants respectfully traverse the rejection in its entirety because a *prima facie* case of obviousness has not been established. However, it is noted that claims 54 and 61 depend on independent claims 46 and 55, respectively. Thus, these claims are allowable based on their dependency on the allowable claims. In the event that the appeal is warranted, Applicants respectfully reserve the right to further submit additional grounds for traversing the rejection during the appeal.

Conclusion

Applicants respectfully request the Examiner to withdraw the outstanding §103(a) rejection and issue a timely Notice of Allowance. In addition, Applicants respectfully invite the Examiner to contact the undersigned attorney if further discussion would facilitate prosecution of the subject application because normally, as the Examiner knows, such discussions enable other sides to clarify any issues in dispute. The undersigned attorney can be reached at the phone number listed below.

Respectfully submitted,

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Dated: 06/09/2005

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